



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,095	03/31/2000	Richard Thomas Box	AND1P051F	2254
29838	7590	05/17/2005	EXAMINER	
OPPENHEIMER WOLFF & DONNELLY, LLP (ACCENTURE)			POND, ROBERT M	
PLAZA VII, SUITE 3300			ART UNIT	
45 SOUTH SEVENTH STREET			PAPER NUMBER	
MINNEAPOLIS, MN 55402-1609			3625	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/540,095

Applicant(s)

BOX, RICHARD THOMAS

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-43, 47 and 49-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-43, 47 and 49-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The Applicant amended claim 40, and canceled claims 44-46, 48, and 70. All claims pending (40-43, 47, and 49-69) were examined in this final Office Action necessitated by amendment.

Response to Arguments

Applicant's arguments filed 03 March 2005 have been fully considered but they are not persuasive.

The combination of Chelliah and IRA teach business-to-government. Chelliah and IRA teach customers accessing individual web storefronts. Storefront 1 accessed by an online customer presents its storefront to the customer, Storefront 2 presents its storefront to the customer, Storefront 3 presents its storefront to the customer, and etc. Specifically Chelliah does not teach presenting in Storefront 2 of Provider 2 to the customer the exact information shown in Storefront 1 of Provider 1, and thereby is sufficient in addressing the Applicant's argument. For example, if the user accesses an IRS storefront (e.g. Storefront 1), one certainly would expect to see a screen reflecting communication with the IRS in its graphical look and feel and not the FDA's graphical look and feel. Any government agency providing services is a specific type of service provider.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 40-43, 47, 49, 50, 52, 53, 56-61, and 63-69 are rejected under 35 USC 103(a) as being unpatentable over Chelliah et al. (Paper #21, US 5,710,887, hereinafter referred to as "Chelliah"), in view of Inland Revenue Agency (a collection of prior art cited in Paper #21, PTO-892, Item: U and PTO-892, Item: U hereinafter referred to as "IRA"), further in view of Tax Forms (Paper #20041028, PTO-892, Item: V hereinafter referred to as "TForms").**

Chelliah teaches a system and method of an electronic mall that facilitates commercial transactions between a plurality of system users (please note: referred to as customers by Chelliah) and at least one provider of goods and services. Chelliah teaches customers communicating online with service providers (please note examiner's interpretation: any government entity that engages in online commerce to provide a service to its citizens is a service provider). Chelliah teaches each service provider having an electronic storefront managed by the electronic mall (please note: this is a portal) (please see at least

abstract; col. 1, lines 20-22; col. 6, lines 4-57; col. 14, lines 47-48). Chelliah further teaches:

- Registering a system user, creating a system user profile: (see at least col. 7, lines 17-19; col. 10, lines 18-25; col. 26, lines 15-19).
- Receiving identification information from the system user: participant program object; use of passwords to secure user information (see at least Fig. 9 (216); col. 9, lines 30-38; col. 9, line 62 through col. 10, line 2; col. 10, lines 28-30; col. 9, lines 49-51).
- Providing secure access to services: Security Subsystem; secure and reliable order and financial transaction processing; RSA public key encryption technology (see at least col. 6, lines 58-65; col. 7, line 15; col. 9, lines 8-19).
- Services limited based on the user profile: narrowcasts targeted services to user based on user's demographics or purchasing habits as defined by participant subsystem and customer accounts subsystem (see at least col. 12, lines 34-42).
- Performing billing functions: receiving electronic payment from user (see at least col. 15, lines 43-49; col. 16, lines 3-20).
- Graphical user interface: communicates with plurality of providers; selects provider; selects products or services (see at least col. 6, lines 31-43; col. 7, lines 46-48; col. 12, lines 43-44).

- Meeting provider requirements: a quantity requirement (see at least col. 18, lines 46-48); meeting a minimum requirement (see at least col. 21, lines 45-47).
- Confirming receipt: confirms; generates receipt (see at least col. 4, lines 27-29; col. 17, lines 31-35).
- Determining tax information: tax engine calculates tax (see at least col. 11, lines 19-24).
- Determining modes of communication: computer, telephone, interactive TV, set-top box, touch sensitive screen (please note examiner's interpretation: system determines mode of communication based on meeting needs of provider) (see at least col. 6, lines 31-34).
- Format and data structure: HTML; object structure, CORBA (see at least col. 14, lines 31-39).
- Customer customized user interface: displays information using narrowcasting to target the customer based on customer's demographics or purchasing habits (please note examiner's interpretation: a) targeting customer based on customer profile, and b) Storefront 1 accessed by an online customer presents its storefront to the customer, Storefront 2 presents its storefront to the customer, Storefront 3 presents its storefront to the customer, and etc. For example, if the user accesses an IRS storefront (e.g. Storefront 1), one certainly would expect to see a screen reflecting communication with the IRS in its graphical look and feel and not

another agency's graphical look and feel) (see at least col. 9, line 64 through col. 10, line 2; col. 12, lines 34-42).

Chelliah teaches all the above as noted under the 103(a) rejection and teaches a) transforming a manual activity with a service provider into an electronic commerce medium activity, b) a system and method of managing a plurality of customers selecting from among a plurality of service providers connected via an electronic mall (please note: equivalent to a portal in providing many-to-many access through a single commerce site), c) a service facilitating online transactions with customers according a standard (please note: standards set by the electronic mall and/or standards implemented by each service provider's legacy system), and d) customers submitting electronic communications using HTML formatted documents with a provider of products or services resulting in an electronic transaction, and e) interacting with a plurality of service providers. Chelliah, however, does not teach the transaction data conforming to a standard being from one of the government agencies. IRA teaches replacing manual activity by conducting business with government departments over the Internet to save money. IRA teaches citizen-to-government online interaction and business-to-government online interaction conforming using electronic forms supplied by the government service provider and receiving completed electronic forms online according to a standard (e.g. standard form CWF1, Inland Revenue self-assessment tax form for businesses, US electronic filing) (Paper #21, U: see at least pages 1 and 2). Therefore it would have been

obvious to one of ordinary skill in the art at time of the invention to modify the method of Chelliah to disclose a government agency as a service provider transacting business with citizens and businesses through an electronic interface according to a standard as taught by IRA, in order for government agencies to participate in an electronic commerce mall system, and thereby encourage businesses to submit filings electronically to save money.

Chelliah teaches all the above as noted under the 103(a) rejection and teaches a) public key encryption technology, b) computing an encrypted payment authorization token based upon the password entered by the user, c) validating the customer's authority, and d) use of digital signatures (see at least col. 16, lines 16-20), but does not disclose digital certificates. IRA teaches all the above as noted under the 103(a) rejection and teaches a) CertCo digital certificate solution supporting Inland Revenue's electronic forms system, b) filing entities digitally signing information and transmitting certificates, and c) authenticating the filer as reliably as with traditional paper documents (U: see pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Chelliah to implement the transmission of digital certificates as taught by IRA, in order to authenticate the filer as reliably as with traditional paper documents, and thereby attract filers to the service.

Chelliah teaches all the above as noted under the 103(a) rejection and teaches customers conducting electronic commerce with a plurality of service providers and selecting among a plurality of business suppliers, but does not

disclose filing a report. IRA teaches all the above as noted under the 103(a) rejection and teaches a) citizens or businesses filing electronic forms with government agencies, and b) the system automatically routing the form to three different government departments (please note examiner's interpretation: automatic routing of one form submitted to Inland Revenue results in two additional agencies receiving the same electronic form clearly suggests that the customer can submit forms directly with the other government agencies as well) (U: see at least pages 1 and 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Chelliah to implement filing a report among a number of government agencies as taught by IRA, in order to conduct electronic form filing activities with a service provider providing government services.

Chelliah and IRA teach all the above as noted under the 103(a) rejection and teach a) tracking and recording customer transactions for historical or real-time analysis (see at least col. 7, lines 40-45; col. 25, lines 65-67), b) the system taking an action and presenting information back to the customer based on past tracked transactions (see at least col. 25, lines 38-67), c) the customer filing a report online with a government entity, and further teach filing tax forms electronically, but do not disclose the report based on at least information from a previous government filing and the user profile. TForms teaches a) speed sells in the tax preparation field, b) electronic filling of tax returns, and further teaches Tax Works from Laser Systems tracking data entry history so that the software

will automatically fill out appropriate information from the customer's prior year's return (please note examiner's interpretation: history information is a profile of the filer) (V: see at least page 5). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Chelliah and IRA to implement automatic filling of customer filing history data as taught by TForms, in order to speed up the process of a customer completing electronic forms, and thereby attract customers to the electronic forms filing service.

2. **Claim 51 is rejected under 35 USC 103(a) as being unpatentable over Chelliah (Paper #21, patent number 5,710,887), IRA (a collection of prior art cited in Paper #21, PTO-892, Item: U and PTO-892, Item: U), and TForms (Paper #20041028, PTO-892, Item: V), as applied to Claim 46, further in view of BroadVision (Paper #20041028, PTO-892, Item: W).**

Chelliah, IRA, and TForms teach all the above as noted under the 103(a) rejection and teach a) accessing service providers through an electronic mall, b) filing reports using electronic forms, and c) making selection from an electronic catalog, but do not disclose a search engine. BroadVision teaches a) search engines that let customers find the exact products they are looking and finding items they desire (W: see at least pages 3 and 4), b) BroadVision supplying Prodigy's Network Shopping Mall with its Internet commerce platform which hosts 30 merchants, and c) Prodigy's electronic mall providing customer shopping via a search engine. Therefore it would have been obvious to one of

ordinary skill in the art at time of the invention to modify the method of Chelliah, IRA, and TForms to implement a search engine to facilitate electronic commerce as taught by BroadVision, in order to help customers find the items they desire, and thereby attract customers to the service.

- 3. Claims 54-55 and 62 are rejected under 35 USC 103(a) as being unpatentable over Chelliah (Paper #21, patent number 5,710,887), IRA (a collection of prior art cited in Paper #21, PTO-892, Item: U and PTO-892, Item: U), and TForms (Paper #20041028, PTO-892, Item: V), as applied to Claim 40, further in view of Proctor (Paper # 15, PTO-892, Item: W).**

Chelliah, IRA, and TForms teach all the above as noted under the 103(a) rejection and teach a) implementing security features (e.g. encrypted tokens for authorization, digital signatures, digital certificates), and b) logging a user's transactions associated with an electronic mall storefront, but do not disclose the monitoring and detection of abusive patterns of use. Proctor teaches the state of the art of intrusion detection systems covering the following topics, but not limited to: monitoring networks and systems for abnormal behavior, and use of audit data to detect patterns of abuse, trending analysis, and audit log reduction and archiving (Paper #15, Item: W, see pages 1-7). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chelliah, IRA, and TForms to include intrusion detection system features as taught by Proctor, in order to improve overall system security and performance, and encourage users to use the online service.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is written over a horizontal line.

Robert M. Pond
Primary Examiner
May 12, 2005